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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,300	12/05/2001	Nobuyoshi Yagi	Q67366	4399

7590 07/26/2005
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

AHMED, SHEEBA

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,300	YAGI ET AL.	
	Examiner	Art Unit	
	Sheeba Ahmed	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-31 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-20, 22-26 and 28-31 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. New claims 27-31 have been added. **Claims 1, 2, and 4-31 are pending of which 8 and 21 have been withdrawn from consideration.**

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7, 9-20, 22-26 and 29-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ***a resin sheet comprising a gas barrier layer having thickness of 2 to 10 microns, a base layer and two hard coat layers respectively as outermost layers, wherein one of the hard coat layers has recesses and protrusions having a peak-to-valley distance of from 20 to 80 microns, and a surface roughness of 80 to 500nm and at least one of the hard coat layer contains 1 to 50 vol. % of transparent particles having a particle size of 0.5 to 30 microns,*** does not reasonably provide enablement for the invention as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Page 10, lines 4-8 of the instant Specification state that "If the thickness of the organic gas barrier layer is smaller than 2 microns, a sufficient gas barrier function

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cannot be imparted. If it exceeds 10 microns, the resin sheet comes to have an increased yellowness index".

Page 15, lines 6-8 of the instant Specification state that "if the peak-to-valley distance of the hard coat layer is smaller than 20 microns or larger than 80 microns, a sufficient antiglare function cannot be imparted".

Page 16, lines 2-6 and the last paragraph of the instant Specification state respectively, that "the transparent particles have a particle diameter of from 0.5 to 30 microns" and "particle diameters smaller than 0.5 microns are undesirable in that the result is insufficient light diffusion, while particle diameters larger than 30 microns are undesirable in that the result is uneven light diffusion" and "the proportion of the transparent particles to the hard coat layer is from 1 to 50% by volume. If the proportion of the transparent particles to the hard coat layer is lower than 1% or higher than 50% , a sufficient light-diffusing function cannot be imparted".

Hence, the above described gas barrier layer thickness, the peak-to-valley distance of the hard coat layer, the size of the transparent particles and the proportion of the transparent particle is critical in practicing the claimed invention.

Response to Arguments

3. Applicant's arguments filed on May 5, 2005 have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 1-7, 9-20, and 22-26 under 35 U.S.C. 112, first paragraph, and state that claims 1-7, 9-20, and 22-26 are enabled because the gas barrier layer thickness, the peak-to-valley distance of the hard

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coat layer, the size of the transparent particles, and the proportion of the transparent particles is not critical and further state that these values are stated as preferred embodiments of the invention.

However the Examiner disagrees. The Specification specifically states that "If the thickness of the organic gas barrier layer is smaller than 2 microns, a sufficient gas barrier function cannot be imparted. If it exceeds 10 microns, the resin sheet comes to have an increased yellowness index", "if the peak-to-valley distance of the hard coat layer is smaller than 20 microns or larger than 80 microns, a sufficient antiglare function cannot be imparted", "the transparent particles have a particle diameter of from 0.5 to 30 microns" and that "particle diameters smaller than 0.5 microns are undesirable in that the result is insufficient light diffusion, while particle diameters larger than 30 microns are undesirable in that the result is uneven light diffusion" and "the proportion of the transparent particles to the hard coat layer is from 1 to 50% by volume. If the proportion of the transparent particles to the hard coat layer is lower than 1% or higher than 50% , a sufficient light-diffusing function cannot be imparted". Hence, the Examiner maintains that upon considering the entire disclosure, it is clear that the gas barrier layer thickness, the peak-to-valley distance of the hard coat layer, the size of the transparent particles, and the proportion of the transparent particles is critical to the invention.

Allowable Subject Matter

4. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed
Art Unit 1773
July 21, 2005